



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,255	10/30/2000	Kenzou Sekiguchi	35.G2225 Div. I	3858

5514 7590 05/07/2002

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

DINH, KHANH Q

ART UNIT PAPER NUMBER

2155

DATE MAILED: 05/07/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
**09/698,255**

Applicant(s)  
**Sekiguchi**

Examiner  
**Khanh Dinh**

Art Unit  
**2155**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Feb 11, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-45 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

Art Unit: 2155

### DETAILED ACTION

1. This is in response to the Request for Continued Examination filed on 2/11/2002. Claims 29-45 are presented for examination.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 29-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa US pat. No.5,765,170 in view of Cannale et al US pat. No.5,619,648.

As to claim 29, Morikawa discloses a communication device comprising:

reception means (Mailbox Manager 2 of fig.1) for sending a transmit request to an email server receiving an email transmitted from the email server in response to the transmit request (i.e., upon receipt of a request for transferring from the data processing system 4 of fig.1, see figs.1, 2, abstract, col.3 line 14 to col.4 line 56 and col.5 line 57 to col.6 line 49).

acquisition means (F0 fig.1) for acquiring size information of an e-mail, stored in the e-mail server (i.e., storing data in folders before sending to the server 6 of fig.1 through data processing systems 3 and 4 of fig.6), from the e-mail server before sending the transmit request to the email server (see col.3 lines 14-64 and col.5 line 56 to col.7 line 37).

Art Unit: 2155

memory for storing e-mails received by said reception means (see fig.1, storing in dedicate folders F1, F2, F3 of fig1).

a judgment means for judging (i.e., controlling classified data information) whether it is possible or not to receive at said communication device an e mail stored in the e-mail server, according to the size information and empty capacity of said memory (i.e., sending information and the length of mail M, see fig.1 and 2, col.2 line 34 to col.3 line 55, col.6 line 2 to col.7 line 37 and col.8 lines 15-67).

Morikawa does not specifically disclose an output means for visually outputting warning information. However, Cannale discloses an output means for visually outputting warning information (using mail filter 119 fig.1) indicating that an e-mail to said communication device, stored in said e-mail server, cannot be received, as a result of said judgment, when said judgment means makes such judgment (i.e., using email filter to reduce junk email and informing users 105(\*n) via interactive user interface that the mail has arrived, see figs.1 and 3, abstract, col.3 line 12 to col.4 line 34 and col.7 line 28 to col.8 line 56). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to utilize Cannale's filter into the system of Morikawa to prevent unwanted data because it would have reduced the amount of unwanted data received by a user of the email system.

As to claim 30, Morikawa discloses size information contains the size of data when an e-mail received from said e-mail server contains various kinds of data (see col.1 line 46 to col.2 line 26

Art Unit: 2155

and col.8 lines 15-67). Morikawa does not specifically disclose data is an image data. However, image data is well known in the art. It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement such data into the system of Morikawa because it would have provided more utilizations of data in the communication network.

As to claim 31, Cannale further discloses a recording means, wherein said output means generates a report indicating said warning information and records it using said recording means (see col.3 line 13 to col.4 line 33 and col.7 line 7 to col.8 line 56). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to utilize Cannale's teachings into the system of Morikawa to prevent unwanted data because it would have reduced the amount of unwanted data received by a user of the email system.

As to claim 32, Morikawa discloses converting a received e-mail into image data and records that e-mail using said recording means (see col.8 line 15 to col.9 line 9).

As to claim 33, Morikawa discloses when a plurality of e-mails are stored in an e-mail server, a communication device executes reception of emails from said e-mail server in a predetermined order, until said judgment means judges that it is impossible to receive an e-mail (see col.2 line 29 to col.3 line 14, col.6 line 33 to col.7 line 58).

Art Unit: 2155

Claims 34-38 are rejected for the same reasons set forth in claims 29-33 respectively.

Claims 39-43 are rejected for the same reasons set forth in claims 29-33 respectively.

As to claims 44 and 45, Morikawa discloses delete request means for requesting deletion of an email stored in the email server based upon a judgment (see figs.4, 6, col.8 line 15 to col.9 line 45).

#### ***Response to Arguments***

4. Applicant's arguments filed on 11/13/2001 (paper # 6) have been fully considered but they are not persuasive.

\* Applicant asserts that Morikawa does not disclose reception means for sending a transmit request to an email server receiving an email transmitted from the email server in response to the transmit request.

*Examiner respectfully disagrees. Morikawa clearly disclose reception means (Mailbox Manager 2 of fig.1) for sending a transmit request to an email server receiving an email transmitted from the email server in response to the transmit request (i.e., upon receipt of a request for transferring from the data processing system 4 of fig.1, see figs.1, 2, abstract, col.3 line 14 to col.4 line 56 and col.5 line 57 to col.6 line 49) as rejected above.*

#### ***Conclusion***

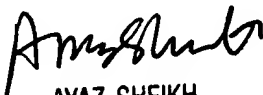
Art Unit: 2155

5. Claims 29-45 are **rejected**.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh, can be reached on (703) 305-9648. The fax phone number for this group is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

Khanh Dinh  
Patent Examiner  
Art Unit 2155  
5/1/2002